



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:)	<u>Group Art Unit:</u> 3622
)	
Leandros KONTOGOURIS)	<u>Examiner:</u> A. Duran
)	
Serial Number: 09/742,438)	<u>Attorney Docket:</u> KONT3001beu
)	
Filed: December 22, 2000)	<u>Confirmation No.:</u> 8890

For: Advertising System And Method Which Provides Advertisers With An Accurate Way Of Measuring Response, And Banner Advertisement Therefor

SECOND SUPPLEMENTAL DECLARATION
TO CLARIFY SUPPLEMENTAL DECLARATION
SUBMITTED ON DECEMBER 14, 2006

Honorable Commissioner For Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

As an Applicant named in the above-identified U.S. Patent Application, I, Leandros Kontogouris, Athens, Greece, hereby declare that:

1. This declaration is intended to clarify certain statements made in the SUPPLEMENTAL DECLARATION TO SHOW DILIGENCE submitted on December 14, 2006, which was supplemental to the DECLARATION OF PRIOR INVENTION submitted under 37 CFR 1.131 on March 8, 2006. The March 8, 2006 declaration of prior invention established a conception date before January 31, 2000. January 31, 2000 is the effective date of U.S. Patent No. 6,636,247 (Hamzy). The DECLARATION TO SHOW DILIGENCE submitted on December 14, 2006 was intended to show diligence to December 22, 2000, the filing date of the present application.

2. Based on a telephone interview between my U.S. representative and the Examiner on October 10, 2007, it is my understanding that the Examiner has mis-understood a number of points raised in the December 14, 2006 declaration to show diligence:

- a. The Examiner understood my evidence of classes attended at INSEAD (a University) from January 31, 2000 to July 1, 2000 to be evidence of work on another invention, which would negate diligence. This was not the intent of the evidence. Instead, the evidence of classes attended at INSEAD was to show that I was a **full-time graduate student** during the period from January 31, 2000 to July 1, 2000. The courses attended were not to work on another invention, but rather were to obtain my Master of Business Administration degree, which in turn was necessary to my **livelihood**.

Because I came up with my invention half-way to completing my program (for which I had received scholarship funding which I would have to return if I were to quit my program), I specifically changed the focus of my studies from Finance to E-commerce and chose elective courses and audited courses that specifically helped me narrow my invention to practice, as indicated by the evidence of classes attended. Despite a heavy class schedule, I worked on reducing my invention to practice every day during this period, except for days off due to illness and a short vacation.

- b. The Examiner considered the almost 11 months between January 31, 2007 to December 22, 2007 to be an **unusually long period** over which to establish diligence. However, the Examiner should consider that at the beginning of this period, I was a full-time graduate student at a university in the countryside of France (not my native Greece). I knew nothing about intellectual property law, much less how to obtain intellectual property protection in the U.S. **I submit that the Examiner should take into account**

my unusual circumstances (i.e., Greek grad student in France seeking to obtain patent protection in the U.S.) in determining whether the diligence period is too long. The “diligence” period that the Examiner considers to be “usual” is likely with respect to a corporation having an engineering department to speed development of the invention, a legal department or outside counsel with at least basic familiarity with obtaining patent protection, and a readily available budget for filing costs and representation to the USPTO. Since patenting of software is generally not permitted in Europe, it was especially difficult for me to obtain U.S. patent protection.

- c. The articles and attachments to the declaration, offered as evidence of my activities, include English language articles and Greek language publications, as well as communications in both English and Greek. The attached spreadsheet indicates their relevance, which is not related to specific content but to the subject matter of the publications and communications. If the Examiner wishes to have translations of any particular documents, I can provide the translations, but providing translations of all documents would be prohibitively expensive in terms of time. It is noted that as a Greek national, it is not surprising that some of my correspondence was in Greek.

- d. According to the case *Griffith v. Danamaru*, 2 USPQ 2d 1361 (Fed. Cir. 1987),

A review of caselaw on excuses for inactivity in reduction to practice reveals a common thread that courts may consider the reasonable everyday problems and limitations encountered by the inventor.

The *Griffith* court then offers the following review of other cases: “See, e.g., *Bey v. Kollonitsch*, 806 F.2d 1024 231 USPQ 967 (Fed.Cir. 1986) (delay in filing excused where attorney worked on a group of related applications and other applications contributed substantially to the preparation of Bey's

application); Reed v. Tornqvist , 436 F.2d 501, 168 USPQ 462 (CCPA 1971) (concluding it is **not unreasonable for inventor to delay completing a patent application until after returning from a three week vacation in Sweden, extended by illness of inventor's father**); Keizer v. Bradley , 270 F.2d 396, 123 USPQ 215 (CCPA 1959) (delay excused where inventor, after producing a component for a color television, delayed filing to produce an appropriate receiver for testing the component); Courson v. O'Connor , 227 F. 890, 894 (7th Cir. 1915) ("**exercise of reasonable diligence * * * does not require an inventor to devote his entire time thereto, or to abandon his ordinary means of livelihood**"); De Wallace v. Scott , 15 App.D.C. 157 (1899) (where applicant made bona fide attempts to perfect his invention, **applicant's poor health, responsibility to feed his family, and daily job demands excused his delay in reducing his invention to practice**); Texas Co. v. Globe Oil & Refining Co ., 12 F.Supp. 455, 98 USPQ 312 (N.D. Ill. 1953) (delay in filing application excused because of confusion relating to war)."

In the *Griffith* case, the inventor admitted a three month delay during which there was no activity, but argued that the delay was excusable because he was waiting for outside funding. In my case, I worked every day on the development of my invention in order to actually reduce it to practice, and in addition to constructively reduce it to practice by filing a patent application in the U.S. Any delay falls within the exceptions described in the above-listed cases, since the delays only involved a few days a time for illness and a short vacation.

- e. At no time during the period in question, did I take time off to work on a different invention. To the contrary, after conceiving my invention during my return to Greece for the Christmas 1999 recess, I immediately went to a Greek attorney, Mr. Manginas, with the requested to help me protect my

invention, the result of which was the notarized disclosure offered as evidence of conception in my first declaration presented in this application. It was the beginning of a one-year long process of hard work, which eventually resulted in the filing of my patent application with the USPTO.

- f. Pursuing my MBA, while at the same time trying to intelligently pursue the implementation of my invention and its appropriate protection, was a daunting task. The INSEAD MBA program is commonly thought to be the most intense MBA program there is. In what is called a fast-track MBA program, the designers of the program have compacted in a single year the entire material of other leading two-year programs. Whereas other programs cover 4-5 topics per semester, in the INSEAD program, five such courses are covered in just six weeks. There are no dormitories and participants are expected to make their own arrangements for board and housing.

The scans of my schedule of classes from that year show that on average participants have four hours of classes per day, and another eight hours of studying. This significantly limits the available time of participants to pursue their interests outside the curriculum of the program. Nevertheless, despite the pressure I was under, I worked diligently on reducing my invention to practice every day during this period, except for two days for a family visit and two days due to illness. My efforts included work on:

- details of implementation of the invention, including development of more detailed flowcharts,
- research on how to establish a company, attract capital, recruit talent, and market my invention, and
- research on patenting my invention in the United States.

These efforts involved selection of classes related to establishing a company to implement my invention, such as "High Technology, Entrepreneurship and Strategy," "Cyber Entrepreneurship," "Managing Continuous Technological Change," and many others, as well as participation in *First Tuesday* entrepreneurial networking events and an e-forum event that I helped organize, and extensive reading about online advertising and intellectual property protection. This was something that I did on a daily basis, as I had become passionate about my invention and its advancement.

- g. My activities during the period from January 31 to my graduation on July 1, 2000 may be summarized as divided between attending classes, for the purpose of ensuring my livelihood, researching fields related to my invention and refining its implementation, and researching patent law in preparation for contacting a U.S. patent attorney. This period lasted for five months. Five months is not an unreasonable period considering the demands of obtaining an MBA at the same time.
- h. Because I am not a U.S. resident or citizen, and had never previously patented an invention in the U.S. or elsewhere, it was necessary to acquaint myself with the U.S. patent system and legal system in general. In order to do so, I first engaged legal assistance in Greece while at the same time researching for myself the U.S. legal system. Because I was a student in Europe researching U.S. patent practice, this took some time, but the spreadsheet attached to the previous declaration shows that I began my research into how to obtain a U.S. patent on February 2, 2000. Copies of the articles collected during this period were attached to the previously submitted declaration.
- i. The approximately **three month** period from July to September brought an acceleration in activities related to development of my invention, despite

moving back to Greece from my university in France. Following my return to Greece, I continued reading and researching the many aspects of my project, which ranged from intellectual property issues to managerial corporate decisions, to financing issues. I also worked on elaborating my model and began to familiarize myself with the format of patent applications (e.g., the "claims" section, the "drawings," etc.) and started producing early versions on how to organize the patent application. In addition, this period included activities related to finding partners and financing for my invention, contact with the Greek Organization for Intellectual Property, contact with the U.S. patent firm of Fenwick & West on September 20, 2000, and ultimately initial contact with the U.S. general practice law firm of Shane Henty P.C. on September 25, 2000. Again, three months to work on my invention, familiarize myself with U.S. patent law, and find and engage a Greek-speaking U.S. attorney, was not an unreasonable period of time considering that I was carrying out these activities on my own from Greece.

- j. My search for a U.S. attorney involved trying to identify American lawyers of Greek origin whom I expected to be more familiar with the constraints I was face with (currency exchange restrictions, limitations of Greek patent laws, the absence of professional financing options in Greece) and who could guide me in my search for a top class patent agent office with a reasonable pricing policy. Overall, I sought a lawyer that: (a) had experience with intellectual property, and (b) could arrange a multitude of issues for me, aside from patent protection, such as non-disclosure agreements, incorporation matters, legal issues related to seeking investors, and so forth. It should be understood that I was doing so from overseas, during a period when most Greek professionals take vacations, and at the same time designing a concrete strategy for implementation of my invention.

- k. The attachments to my previous declaration show that I initially approached Mr. Lefteris "Ted" Georgiou, a recent Greek-American graduate of law school, whom I had met in Greece through my sister. I knew he was a trainee in the NYC-based Shane Henty Sutton law firm, which was partly run by another Greek-American lawyer, Mr. Panayis "Peter" Moulinos. I sought and found Mr. Georgiou's contact details and contacted him to solicit his assistance. Mr. Georgiou in turn introduced me to Mr. Moulinos and, after having them sign non-disclosure agreements, I presented them with the draft patent text for my invention. I had prepared this draft myself to facilitate and speed up the filing process. The Shane Henty Sutton Law Office undertook to identify an appropriate patent agent on my behalf, and to help me with other legal issues associated with implementation of my invention
- l. The **two and a half month** period from September 25 to December 7, 2007 were spent negotiating with my U.S. general practice (non-patent) attorney concerning details of a representation/equity agreement, and further development of my invention and research on U.S. patent law. During this time, my U.S. attorney contacted my patent attorney and arranged and a draft patent application was prepared. In addition, as shown by the spreadsheet and attached materials, I continued to develop my invention and research U.S. patent law issues. **Two and a half months (which elapsed after familiarizing myself with U.S. patent practice and locating a Greek-speaking general practice attorney in the U.S.) was not an unreasonable period for someone in my circumstances to find and engage a U.S. Patent Attorney.**
- m. While searching for an engaging an attorney, I also recruited the following persons to help me implement my invention. As a recent graduate, I did not already have a staff or assistants to help with this process. Among the persons recruited were:

- Dr. Vassilis Tsamourtzis, an experienced engineer and project manager and a Greek colleague from INSEAD;
- Mr. Dimitris Spiliotis, an accomplished Greek-American strategy consultant, who was due to also graduate from INSEAD;
- Mr. Andreas Vouros, a technologist, mathematician, and friend that could assist with assessing subcontracting parties to whom we were planning to outsource the development of parts of our software solution;
- Mr. Sergios Photiades, as talented U.S. educated industrial designer and a friend, who was willing to help me with the graphics and the appearance of the software application; and
- Mr. Vassilis Kokodinis, a talented programmer in his final year in the Athens University.

As a result, it can be seen that during the period following my graduation, I did much more than merely read about my invention. In addition to continuing research and refinement of my invention, I located an appropriate U.S. attorney and used my research to prepare a draft patent application (not an easy task for someone unfamiliar with U.S. patent law), and in addition assembled a team to help me with implementation of the invention.

- n. Finally, after my first contact with my U.S. patent attorney on December 7, 2007, I reviewed the draft, reviewed a final draft, and arranged for filing of the application on December 22, 2000. **Three weeks from first contact with the patent attorney to filing of the application is clearly not an unreasonably long period of time.**
- o. It must be kept in my mind that I am an individual inventor rather than a corporation, and that I was a student in a foreign country during much of the ten month critical period. In addition to working on my invention, I need to

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keep up with my studies and earn a living. As a citizen of Greece, I was unfamiliar with U.S. law in general, and in particular patent practice, and therefore had to spend much time learning about the process, including how to find and retain a U.S. patent attorney. Also, I had to learn how to set up, fund, and staff a company capable of actual reduction of my invention to practice. I made significant progress in all of these areas during the ten month period.

3. The person making this declaration is the inventor.

TIME OF PRESENTATION OF THE DECLARATION

4. This declaration is submitted together with a Request for Continued Examination.

ASSIGNMENT OF INVENTION

5. This application has not been assigned.

DECLARATION UNDER 18 USC §1001

6. As a person signing below:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that willful false statements and the like so made are punishable by fine or imprisonment or both, under §1001 of Title 18 of the United States code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Serial Number 09/742,438

October 30, 2007
Date

Leandros Kontogouris
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